

**REMARKS/ARGUMENTS**

***Amendments in General / Claim Rejections - 35 U.S.C. § 112***

1. **Specification.**

- a. The Examiner objected to the specification having quotations marks in the title and lacking headings.
- b. Applicant has amended the Specification to address these issues.
- c. Clean and marked up copies of the Specification are attached.
- d. The original paragraph beginning on line 79 included an underlined phrase “per se”. The Applicant, in the Substitute Specification, has replaced that paragraph with an identical paragraph that does not include underlining.
- e. The quotations have been removed from the title.
- f. Headings have been added.
- g. All such amendments to the Specification add no new matter.

2. **Claim Objections**

- a. The examiner objected to claims 4-11 as being in improper form because of a multiple dependent claim.
- b. The Applicant has amended claims 4, and 6-9 to address this issue.
- c. No new matter was added through such amendment.

3. **Claim Rejections – 35 U.S.C. §112**

- a. Claims 1-3 are rejected under §112 as being indefinite.

b. Applicant has amended claims 1-11 to address all issues with indefiniteness that were noted. If additional amendments are necessary, please let Applicant know.

c. Such changes add no new matter.

4. **Standards for Patentability**

a. "An applicant for a patent is entitled to the patent unless the application fails to meet the requirements established by law. It is the Commissioner's duty (acting through the examining officials) to determine that all requirements of the Patent Act are met. The burden is on the Commissioner to establish that the applicant is not entitled under the law to a patent .... In rejecting an application, factual determinations by the PTO must be based on a preponderance of the evidence, and legal conclusions must be correct." *In re Oetiker*, 977 F.2d 1443, 1449, 24 USPQ2d 1443, 1447 (Fed. Cir. 1992) (Judge Plager concurring).

b. "The precise language of 35 USC 102 that 'a person shall be entitled to a patent unless,' concerning novelty and unobviousness, clearly places a burden of proof on the Patent Office which requires it to produce the factual basis for its rejection of an application under sections 102 and 103." *In re Warner*, 379 F.2d 1011, 1016, 154 USPQ 173 (CCPA 1967), cert. denied, 389 U.S. 1057, reh'g denied, 390 U.S. 1000 (1968).

5. **Claim Rejections - 35 USC § 102**

a. Claims 1-3 are rejected under 35 U.S.C. §102(b) as being anticipated by USPN 4,441,293 to McQueen, et al. (herein "McQueen").

b. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d. 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 828 F.2d 1226,1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). MPEP § 2131.

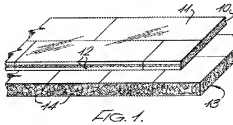
c. Applicant believes that the Examiner has misinterpreted the teachings of McQueen.

d. Claim 1 (as amended) recites that the claimed panel comprises an insulating core and two outer faces, with “a cushion of mineral wool interposed between at least one of said outer faces and said insulating core.”

e. The Examiner argues that McQueen “disclose a panel comprising an insulating core 10, two outer faces 11...[and] a cushion of mineral wool 13...interposed between at least one of said outer faces and the insulating core...” (Action, page 3).

f. However, that is not what McQueen shows. McQueen, does not show “an insulating core 10” as the Examiner argues. In fact, the call out number “10” is used to represent “non-combustible fire-resisting fibre-reinforced board 10” (col. 2, ll. 24-25).

g. As it can be easily appreciated from the drawing (Fig. 1) from McQueen below, McQueen discloses veneer-faced (11) boards (10) having a layer (13) of mineral wool fibers (preferably comprising a slab (14)). No insulating core is disclosed. No insulating core is provided adjacent to the layer of mineral wool fibers. McQueen does not anticipate.



h. In this connection it is worth noting that the paragraph quoted by the Examiner (McQueen, col. 1, l. 63) relates to the possible construction of a “floating floor” by assembling a number of panels according to the teaching of the cited reference. This passage can in no way anticipate the panel of claim 1 above, because even considering the floor equivalent to a panel like the Examiner did, there would always be a series of panels juxtaposed one to the other but each comprising a single mineral cushion interposed between two outer metal faces, without any insulating core adjacent thereto.

i. In that the reference fails to teach all of the elements of claim 1, claim 1 and the claims that depend there-from are not anticipated. The rejection should be withdrawn.

j. Because the Office Action makes only a general allegation that a claim feature is taught (or suggested) by cited art, finality of the next action is precluded.

***Conclusion***

If the Examiner feels it would advance the application to allowance or final rejection, the Examiner is invited to telephone the undersigned at the number given below.

Reconsideration and allowance of the application as amended is respectfully requested.

DATED this 14<sup>th</sup> day of October, 2008.

Very respectfully,

/Stephen M. Nipper/

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**CERTIFICATE OF EFS-WEB TRANSMISSION UNDER 37 CFR 1.8**

I HEREBY CERTIFY that this correspondence is being transmitted to the United States Patent and Trademark Office by EFS-Web on the date below.

DATED this 14<sup>th</sup> day of October, 2008.

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